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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,948	10/21/2004	Wolfgang Kratzenberg	DT-6897	8679
30377 7590 01/30/2008				
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
01/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,948

Applicant(s)

KRATZENBERG ET AL.

Examiner

JAMES W. MYHRE

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the preliminary amendment filed on October 21, 2004. The preliminary amendment did not add nor delete any claims, but did amend Claims 3-16 to correct multiple dependency problems with these claims. Therefore, the currently pending claims considered below are Claims 1-16.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 12 recites the limitation "the provision of the different advertising messages" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

The parent claim (Claim 1) of this claims refers to "outputting at least one, preferably a number of different advertising displays is associated". There is no mention of "provisioning" the advertising messages; however, the Examiner assumes that the Applicant was referring to the outputting of the advertising messages and will use this assumption when considering the claim below.

5. **Examiner's Note.** It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in Claims 4 and 5 by using "means-plus-function" language, such as "the means emitting the encoded signals" and "means emitting coded signals", respectively, in the above claims. In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function language; (2) the claim itself must not provided structural limitations to the means-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function language in the claim. While the above claims pass the first prong of the three prong test, since the claims specifically identify the means as "in particular the interrogating transponder" and "in particular a interrogating transponder", respectively, they do not pass the second prong. Therefore, 35 U.S.C 112, 6th paragraph has not been successfully invoked. The Examiner will consider the means to perform the claimed function as an interrogating transponder.

Claim Objections

6. Claim 11 is objected to because of the following informalities: in line 4 the phrase "during a running time a triggered is not activated again". This is not clear and appears to be in improper English. The Examiner assumes the Applicant is attempting to claim that the device "prevents the information carrier from being triggered again by other signal emitters entering the transmitting area of the transmitting/receiving system during the run time of a currently triggered advertising display", and will use this assumption while considering the claim below. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes, Jr. (US 2003/0065805) in view of Hind et al (US 2003/0174025).

Claim 1: Barnes discloses a system for use in a facility, such as a shopping center, for presenting advertising messages on a plurality of information carriers ("fixed presentation devices") located throughout the facility (page 25, paragraph 0261).

Barnes further discloses that the advertisement is selected based on a signal received from the user device uniquely identifying the user/user device (page 10, paragraph 0101; page 22, paragraph 0227 – page 23, paragraph 0237; page 25, paragraph 0261; and page 28, paragraph 0290), the signal activating the information carrier (page 2, paragraph 0032 and page 26, paragraph 0264).

While Barnes does not explicitly disclose that the user device is mounted on a shopping cart, Hind discloses a similar system for presenting targeting advertising to shoppers in a shopping center (page 2, paragraph 0022) in which the user device (RFID tag) is read by or inserted into a device mounted on a shopping cart (page 3, paragraphs 0030-0033). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Barnes to use a similar shopping

cart mounted device. One would have been motivated to use a device mounted on the user's shopping cart in order to provide a more consistent power supply (e.g. a shopping cart battery can be much larger than one that the user must hand carry around) and to provide space for the user to carry purchased goods. The Examiner notes that once the user has scanned or inserted their RFID tag or card into the shopping cart, that specific shopping cart is then uniquely identified to the system.

Claims 2, 3, and 9: Barnes and Hind disclose a system as in Claim 1 above, and Barnes discloses the fixed presentation devices are activated when the user approaches them. While not specifically stated, this implies that the fixed presentation devices can be switched on and off (i.e. activated, de-activated) multiple times throughout the business hours of the facility depending on user traffic in its vicinity. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the fixed presentation devices could be switched off during periods of inactivity (e.g. non-business hours or no user traffic) in order to conserve power, or that they could be left on and display one or more default advertisements to passer-bys who may not have a compatible user device (or shopping cart). These would be design options from which the system designer could choose when setting up the system or changed later as so desired. It would be most likely that the system designer would use both options, e.g. present default advertisements during business hours and turn off the fixed presentation devices during non-business hours.

Claims 4 and 5: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses locating the fixed presentation devices near the entrances and exits of the facility (page 22, paragraph 0229) and Hind further discloses the shopping cart is activated (i.e. reset) upon the user entering the user identification information (RFID tag, card, etc.) as discussed above. Barnes also discloses that the user device is uniquely identified (page 10, paragraphs 0104 – 0109). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Barnes to reset the shopping card device to reflect the user's unique identifying information. One would have been motivated to reset the shopping cart device in order to assure the targeted advertisements are directed to the correct user.

Claim 6: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses the information carriers (fixed presentation devices) are equipped with a device for querying the data of the shopping carts (page 25, paragraph 0261).

Claims 7 and 8: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses the vendor (advertiser) sets the display parameters for the advertisements, such as the maximum number of transmissions (i.e. displays), maximum amount of advertising resources (e.g. budget), etc. (page 26, paragraph 0271). Barnes also discloses that the system tracks other statistics, such as the length of time since an advertisement was last displayed during a specific time period, etc. (page 26, paragraphs 0265 – 0271). Thus, it would have been obvious to one having

ordinary skill in the art at the time the invention was made for Barnes to include a counter device in order to determine when the pre-set maximum number is reached and to include a time cycle device to ensure the same advertisement is not shown consecutively. (It is well known in the advertising art that such consecutive exposure quickly leads to the advertisement not even registering on the user's consciousness.)

Claim 10: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses the fixed presentation devices are activated when the user approaches them. This implies that the fixed presentation device "is assigned a limited switch-on time" corresponding to the length of the advertisement being displayed.

Claim 11: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses that the fixed presentation device may present an advertisement to a plurality of users based on the similar characteristics of persons who are likely to view the presentation device, i.e. select and present one advertisement that best fits a plurality of viewers instead of attempting to present a specific advertisement to each viewer which would cause contention. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Barnes to prevent a subsequently received trigger signal from activating the fixed presentation device (i.e. selecting and displaying an advertisement targeted to that specific user) while an advertisement is already being displayed. One would have been motivated to prevent such contention in

order to allow the first advertisement to play in full and not be interrupted; thus, enabling the advertiser to be fairly charged for its display.

Claim 12: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses providing the advertisements using a wireless remote control system (page 4, paragraphs 0041-0053; page 10, paragraph 0101; page 17, paragraph 0169; and page 30, paragraph 0299).

Claim 13: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses a centralized system with a plurality of fixed presentation devices connected to the central system (page 23, paragraph 0236),

Claim 14: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses a centralized system that only displays advertisements that have been paid for (i.e. stay within the advertiser's predetermined budget) (page 26, paragraph 0271).

Claim 15: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses collecting statistical data from each of the fixed presentation devices (page 24, paragraph 0246 and page 25, paragraph 0257).

Claim 16: Barnes and Hind disclose a system as in Claim 1 above, and Barnes further discloses the central server (superordinate management computer) is associated with an optional number of systems/fixed presentation devices ("up to 255 parked slaves") (page 4, paragraph 0052).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. McNicol et al (6,615,179) discloses a system for presenting location-based targeted advertisements to shoppers via data distribution nodes located "near entrances and kiosk locations throughout a mall of shopping center".

b. Melaku et al (7,308,356) discloses a system for using a smart shopping cart with a display device for presenting targeted advertisement to the user based on the location within the shopping facility.

c. Herz et al (US 2001/0014868) discloses a system for presenting targeted advertisements to shoppers using an advertising billboard or point-of-sale kiosk that has recognized the shopper through the shopper's PDA, smart card, etc.

d. Hankla (US 2001/0032122) discloses a system for presenting just-in-time demographically-targeted advertising on display units located along aisles in a shopping mall.

e. Banerjee et al (US 2002/0147638) discloses a system for selecting targeting advertisements based on the demographics and activities of the shopper, such as the movement of a shopper through a shopping facility, and then present the advertisement to the shopper on a device, such as an interactive kiosk.

f. Bearden, III et al (US 2003/0014275) discloses a system for presenting targeted information to a user on such devices as a scoreboard or other large display device within a sports arena.

g. Maritzen et al (US 2004/0098740) discloses a system for using a "parasitic kiosk" in communication with the user's PDA, smart card, etc. for presenting commerce information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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JWM

January 28, 2008

/James W Myhre/

Primary Examiner, Art Unit 3622